IN THE HIGH COURT OF JUDICATURE AT BOMBAY

ORDINARY ORIGINAL CIVIL JURISDICTION

APPEAL NO. 914 OF 2006

IN

NOTICE OF MOTION NO. 4503 OF 2006

IN

SUIT NO. 3570 OF 2006

Cadila Healthcare Ltd..... ..... Appellant.

Versus

Macleods Pharmaceuticals Pvt.Ltd.... Respondent.

Mr.Aspi Chinoy, Senior Counsel with Mr.Bijal Chhatrapati and Mr. J. Desai i/by M/s. Singhi & Co., for the Appellant.

Mr.Mahendra Shah with Ms.Alpana Ghone i/by M/s.Sonal Doshi & Co. for the Respondent.

CORAM : R. M. LODHA, and
S. A. BOBDE, JJ.

DATED : 21ST DECEMBER, 2006.

P.C.:

We heard Mr. Aspi Chinoy, Senior Counsel for the appellant and perused the impugned order.

2. We find from the documents at pages 40, 42, 43 and 44 of the paper book that the other brands having prefix of "Dox" are largely available in the market. Even the brand having a prefix "Doxo" by name "Doxobid" is available in the market prior to the

product marketed by the present appellant in the month of September, 2006. Doxobid had a sale of Rs.80,67,116/- for the period between January, 2006 and September, 2006.

3. It is an admitted position that the appellant-(plaintiff) started marketing their product having mark "Doxolin" from the month of September, 2006. Though the plaintiff claims to have acquired reputation and goodwill in the said mark, prima facie, at this stage we are unable to accept the plaintiff's claim to that extent. The distinction has to be drawn in the reputation of the mark and the reputation of the maker. The plaintiff may have extremely good reputation as maker of pharmaceutical products but in so far as the product Doxolin is concerned, the mark cannot be said to have acquired any reputation having only being marketed since September, 2006.

4. Mr. Aspi Chinoy, Senior Counsel for the appellant-plaintiff, submitted that the defendant is estopped from contending that the mark "Doxolin" is derived from the generic name as they themselves have applied for registration of their trade mark "Doxoril". Reliance is placed on the single bench judgment of the Delhi High Court in the case of **Automatic Electric Limited vs R.K.Thawed & Nr.**, 1999 PTC (19) 81. It is not necessary to deal with this

aspect with great length but suffice it to say that it is open for the defendant to contend that the prefix "Doxo" has been derived from the generic name "Doxofylline" and, therefore, merely because the defendant has applied for the registration of their trade mark "Doxoril", it cannot be held at this stage that the defendant is estopped from contending that there are several marks on the register or in the market with prefix "Doxo". All in all, refusal to grant ad-interim relief by the learned Motion Judge does not call for any interference.

5. Appeal is dismissed in limine.

Sd/-

(R. M. LODHA, J.)

Sd/-

(S. A. BOBDE, J.)